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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,128	07/29/2003	Joseph M. Asher	CF-84	5903
1473	7590	08/11/2006	EXAMINER	
FISH & NEAVE IP GROUP			HAQ, NAEEM U	
ROPES & GRAY LLP			ART UNIT	
1251 AVENUE OF THE AMERICAS FL C3			PAPER NUMBER	
NEW YORK, NY 10020-1105			3625	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,128

Applicant(s)

ASHER ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) 2-18, 23-33, 48-71, 77-85 and 99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 19-22, 34-47, 72-76, 86-98 and 100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/14/2004; 12/22/2003; 7/29/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of claims 1, 19-22, 34-47, 72-76, 86-98, and 100 in the reply filed on June 29, 2006 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39, 40, 91, and 92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims recite the word "substantially". This term is a relative term which renders the claim indefinite because the term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 19, 20, 34-38, 41-47, 73, 74, 86-90, 93-97, and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US 6,243,691 B1) in view of Toth (US 2003/0078793 A1).

Referring to claim 1: Fisher teaches an apparatus for implementing an automated auction process, the apparatus comprising: a plurality of workstations, each of the workstations comprising: a workstation storage device; a workstation processor connected to the workstation storage device, the workstation storage device storing a workstation program for controlling the workstation processor; and the workstation processor operative with the workstation program to receive bids on at least one item, and announce a current bid (col. 6, lines 15-26); and a server operative to communicate with the plurality of workstations and receive the bids on the at least one item, the server comprising: a server storage device; a server processor connected to the server storage device, the server storage device storing a server program for controlling the server processor (col. 6, line 61 – col. 7, line 35); and the server processor operative with the server program to determine the current bid based on the received bids (col. 7, line 36-42) and to stop accepting subsequent bids after a pre-determined time period has elapsed following the determination of the current bid (col. 12, line 62 – col. 13, line

24). Fisher does not teach displaying an animated auctioneer that makes an announcement. However, Toth discloses an animated character that makes announcements and solicits orders from customers in a commercial environment (Figure 1, items "105" and "135"; paragraph [0072]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Toth into the apparatus of Fisher. One of ordinary skill in the art would have been motivated to do so in order to allow users to have a more human-like interaction with a commercial system, as taught by Toth (Abstract, lines 5-7).

Referring to claim 19: Fisher and Toth teaches or suggest all the limitations of claim 1 as noted above. Furthermore, Fisher teaches soliciting bids from a user (col. 6, lines 15-26). Fisher does not teach that the bid is solicited by an animated character. However, Toth discloses an animated character that makes announcements and solicits orders from customers in a commercial environment (Figure 1, items "105" and "135"; paragraph [0072]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Toth into the apparatus of Fisher. One of ordinary skill in the art would have been motivated to do so in order to allow users to have a more human-like interaction with a commercial system, as taught by Toth (Abstract, lines 5-7).

Referring to claims 20: The cited prior art teaches or suggest all the limitations of claim 19 as noted above. The cited prior art does not teach a set of genre-based characters. However, the Examiner notes that this limitation is not functionally involved

in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The structural elements of the system would be the same regardless of type of animated character selected. The differences between the content of the Applicants' invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any animated characters in the cited prior art because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 34: The cited prior art teaches or suggest all the limitations of claim 19 as noted above. Furthermore, Fisher teaches that the pre-determined time period comprises a first pre-determined time period (col. 12, line 62 – col. 13, line 24).

Referring to claim 35: The cited prior art teaches or suggest all the limitations of claim 19 as noted above. Furthermore, Toth discloses an animated character that makes announcements and solicits orders from customers in a commercial environment (Figure 1, items "105" and "135"; paragraph [0072]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Toth into the apparatus of Fisher. One of ordinary skill in the art would have been motivated to do so in order to allow users to have a more

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human-like interaction with a commercial system, as taught by Toth (Abstract, lines 5-7).

Referring to claim 36: The cited prior art teaches or suggest all the limitations of claim 35 as noted above. Furthermore, Fisher teaches soliciting bids from a user (col. 6, lines 15-26). Fisher does not teach that the bid is solicited by an animated character. However, Toth discloses an animated character that makes announcements and solicits orders from customers in a commercial environment (Figure 1, items "105" and "135"; paragraph [0072]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Toth into the apparatus of Fisher. One of ordinary skill in the art would have been motivated to do so in order to allow users to have a more human-like interaction with a commercial system, as taught by Toth (Abstract, lines 5-7).

Referring to claims 37, 38, and 41-45: The cited prior art teaches or suggest all the limitations of claim 36 as noted above. The cited prior art does not teach a second or third announcement. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The structural elements of the system would be the same regardless of type or number of announcements made by the animated character. The differences between the content of the Applicants' invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.

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1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the animated characters in the cited prior art make any type or number of announcements because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 46: The cited prior art teaches or suggest all the limitations of claim 1 as noted above. Furthermore, Fisher teaches that the server and the plurality of workstations are connected through the Internet (col. 6, lines 65-67).

Referring to claim 47: Fisher teaches a method for implementing an automated auction process, the method comprising: displaying product information relating to at least one item on an interactive screen (col.7, lines 2-20); following a determination of a highest bid, setting a pre-determined time period after which no bids on the at least one item are accepted (col. 7, lines 36-41; col. 12, line 49 – col. 13, line 24); receiving at least one bid on the at least one item (col. 7, lines 12-19); determining a current bid on the at least one item based on the at least one bid (col. 7, lines 36-41); and announcing the current bid on the at least one item (col. 6, lines 15-26). Fisher does not teach displaying an animated auctioneer that makes an announcement. However, Toth discloses an animated character that makes announcements and solicits orders from customers in a commercial environment (Figure 1, items “105” and “135”; paragraph [0072]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Toth into the apparatus of

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Fisher. One of ordinary skill in the art would have been motivated to do so in order to allow users to have a more human-like interaction with a commercial system, as taught by Toth (Abstract, lines 5-7).

Referring to claim 73: Claim 73 is rejected under the same rationale as set forth above in claim 19.

Referring to claim 74: Claim 74 is rejected under the same rationale as set forth above in claim 20.

Referring to claim 86: Claim 86 is rejected under the same rationale as set forth above in claim 34.

Referring to claim 87: Claim 87 is rejected under the same rationale as set forth above in claim 35.

Referring to claim 88: Claim 88 is rejected under the same rationale as set forth above in claim 36.

Referring to claim 89: Claim 89 is rejected under the same rationale as set forth above in claim 37.

Referring to claim 90: Claim 90 is rejected under the same rationale as set forth above in claim 38.

Referring to claim 93: Claim 93 is rejected under the same rationale as set forth above in claim 41.

Referring to claim 94: Claim 94 is rejected under the same rationale as set forth above in claim 42.

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Referring to claim 95: Claim 95 is rejected under the same rationale as set forth above in claim 43.

Referring to claim 96: Claim 96 is rejected under the same rationale as set forth above in claim 44.

Referring to claim 97: Claim 97 is rejected under the same rationale as set forth above in claim 45.

Referring to claim 100: Claim 100 is rejected under the same rationale as set forth above in claim 46.

Claim 21, 22, 72, 75, 76, and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US 6,243,691 B1) in view of Toth (US 2003/0078793 A1) and further in view of Official Notice.

Referring to claim 21: The cited prior art teaches or suggest all the limitations of claim 19 as noted above. The cited prior art does not teach seeking confirmation from the user for a bid placed by the user. However, Official Notice is taken that it is old and well known in the art to seek a confirmation of a transaction before processing the transaction. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to confirm a bid placed by a user before processing the bid in the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to change or cancel the bid.

Referring to claim 22: The cited prior art teaches or suggest all the limitations of claim 19 as noted above. The Fisher does not teach displaying an animated auctioneer that makes an announcement. However, Toth discloses an animated character that

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makes announcements and solicits orders from customers in a commercial environment (Figure 1, items "105" and "135"; paragraph [0072]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Toth into the apparatus of Fisher. One of ordinary skill in the art would have been motivated to do so in order to allow users to have a more human-like interaction with a commercial system, as taught by Toth (Abstract, lines 5-7).

Referring to claim 72: The cited prior art teaches or suggest all the limitations of claim 47 as noted above. The cited prior art does not teach allowing a user to retract a bid during a pre-determined time period. However, Official Notice is taken that it is old and well known in the art to allow a user to retract a bid before a certain time period has elapsed. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to change his or her mind.

Referring to claim 75: Claim 75 is rejected under the same rationale as set forth above in claim 21.

Referring to claim 76: Claim 76 is rejected under the same rationale as set forth above in claim 22.

Referring to claim 98: The cited prior art teaches or suggest all the limitations of claim 47 as noted above. The cited prior art does not teach prompting a user for a username and password. However, Official Notice is taken that it is old and well known

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in the art to request a username and password from a user. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to ensure that the user was properly authenticated before the system accepted his or her bid.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Naeem Haq', with a stylized flourish at the end.

Naeem Haq, Primary Examiner
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August 7, 2006